

Applicant : Gary K. Schwartz
U.S. Serial No.: 10/693,301
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REMARKS

Claims 31-38 and 41-42 are pending in this application. By this Amendment, Applicant has hereinabove amended claim 31 according to the suggestion of the Examiner to whom this application has been assigned. Furthermore, Claims 41 and 42 have been amended to capitalize the term Taxol[®], indicate that the said mark is registered and accompany the trademark with generic terminology. The Amended claims 31, 41 and 42 are fully supported by the specification and there is no issue of new matter. Accordingly, Applicant respectfully requests the entry of this Amendment.

Claim Objections

The Examiner to whom this application is assigned stated that Claims 41 and 42 are objected to because of the presence of the trademark Taxol[®].

In response, Applicant has hereinabove added [®] after Taxol. Applicant believes that the amended claims should obviate this ground of rejection.

Claim Rejections - 35 U.S.C. § 112, first paragraph

The Examiner has rejected Claim 31 under 35 U.S.C. § 112, first paragraph because the specification does not reasonably provide enablement for all the possible methods of extraction.

In response, but without conceding the correctness of the Examiner, Applicant has amended claim 31 which now recites: "A method for treating cancer in a subject comprising administering to the subject an effective amount of aqueous coptis chinesis extract."

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Applicant believes that amended claim 31 is fully enabled by the specification and respectfully requests the withdrawal of the above ground of rejection.

Furthermore, Claims 34, 35, 41 and 42 are rejected under 35 U.S.C. § 112 as failing to comply with the written description requirement. The Examiner stated that the claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, has possession of the claimed invention.

In response, Applicant respectfully traverse the about ground of rejection. Claim 34 recites: The method of claim 33, further comprising a protein kinase C inhibitor. Please find attached hereto as **Exhibit A** and **Exhibit B** two (2) previously obtained patents by the named inventor of the above-identified application. Many protein kinase C inhibitors are described in these two patents. Accordingly, Applicant respectfully requests the withdrawal of the above-ground of rejection.

Similarly, claim 35 recites a microtubule-destabilizing agent which is well known in this field. Please find attached hereto as **Exhibit C** and **D** two (2) references disclosing different microtubule-destabilizing agents.

In response but without conceding the correctness of the Examiner and to expedite the prosecution of this application Applicant has eliminated the term taxol-like from pending claims 41 and 42, thereby rendering this ground of rejection moot.

Claim Rejections - 35 U.S.C. § 112, second paragraph

The Examiner to whom this application is assigned has rejected claims 41 and 42 under 35 U.S.C. § 112, second paragraph as

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being indefinite for failing to particularly point out and distinctly claims the subject matter which applicant regards as the invention.

In response but without conceding the correctness of the Examiner, Applicant has hereinabove amended claim 41 and 42 to eliminate the term taxol-like, thereby rendering this ground of rejection moot.

Claim Rejections - 35 U.S.C. § 102

The Examiner to whom this application is assigned has rejected claims 31-34 under 35 U.S.C. § 102 (b) as being anticipated by Hong-fen, et al., as evidenced by Xu, et al. and Das, et al.

In response, Applicant respectfully traverse the about ground of rejection. Hong-fen does not teach a method for treating cancer in a subject comprising administering to the subject an effective amount of coptis chinesis extract.

The citation noted on page 14 of the Office Action is related to mixture of herbs where coptis chinesis is only one of them. Hong-fen does not enable uses of extract of coptis chinesis for cancer treatment and cannot anticipate the applicant's claimed invention. Accordingly, Applicant respectfully requests the reconsideration and withdrawal of the above ground of rejection.

Claim Rejections - 35 U.S.C. § 103

The Examiner to whom this application is assigned has rejected claims 31-38, 41 and 42 under 35 U.S.C. § 103 (a) as being unpatentable over Hong-Fen, et al., in view of Xinxian and Alloatti, et al.

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In response, Applicant respectfully traverse the about ground of rejection. Applicant's claimed invention is uses of coptis chinesis extract for treatment of cancer. Hong-fen does not teach a method for treating cancer in a subject comprising administering to the subject an effective amount of coptis chinesis extract. Hong-fen's extract includes many other herbs.

Admitted by the Examiner, Xinxian teaches uses of more than one herb. See the Office Action, page 16, last sentence of the first paragraph. Therefore, it cannot teach or render the Applicant's invention which teaches that a single herb extract can be used to treat cancer, obvious.

Therefore, in view of the foregoing, applicant maintains that none of the cited reference, Hong-fen, Xinxian, and Aloatti renders the claimed invention obvious. Applicant respectfully requests the reconsideration and withdrawal of this ground of rejection.

Replacement Drawings

Applicants hereby submit as **Exhibit E** replacement drawings, i.e., Figures 1, 6, 10, 13 and 14 in compliance with 37 CFR 1.84 and 37 CFR 1.121. In response to the Examiners request Figure 1 has been changed to include the term Prior Art on the same page of the figure. Furthermore, Figures 6, 10, 13 and 14 have been resubmitted in a better quality version. Accordingly, there is no issue of new matters, and Applicant respectfully requests these figures to be entered.

Information Disclosure Statement

Examiner stated in the pending action that reference numbers six (6) and eight (8) were not considered because they were not received at the time that the December 11, 2003 Information

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Disclosure Statement (IDS) was filed. However, Applicant did submit all references with the IDS filed on December 11, 2003 i.e., (1-23). Furthermore, Applicants received a return receipt postcard from the USPTO attached hereto as **Exhibit F** indicating receipt of the said IDS and all twenty-three (23) references. Without conceding the correctness of the Examiner and to expedite the prosecution of this case Applicants hereby re-submit reference numbers six (6) and (8) as listed in the December 11, 2003 IDS as **Exhibit G** and further resubmit form PTO/SB/08B as **Exhibit H**. Applicant respectfully requests the Examiner to consider the two mentioned references as of the original December 11, 2003 date.

#6. G.D. Wang, Y.M. Zhang and X.Y. Xiong, "Clinical and experimental study of burns treated locally with Chinese herbs", Chung Hsi I Chieh Ho Tsa Chih (1991 Dec) 11(12):727-9, 709.

#8. Kobayashi, Y. Yamashita, N. Fuji, K. Takaboshi, T. Kawakami, M. Kamwamura, T. Mizukami, and H. Nakano, "Inhibitors of DNA topoisomerase I and II isolated from the Coptis rhizomes". Planta Med 61: 414-418, 1995

In summary, Applicant believes that all grounds of rejections have been addressed and earnestly requests the Examiner to place this application in condition for allowance.

If a telephone interview would be of assistance in advancing the prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

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No fee is deemed necessary in connection with the filing of this Communication. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 50-1891. Conversely, authorization is also hereby given to credit the amount of any overpayment to Deposit Account No. 50-1891.

Respectfully submitted,

Albert Wai Kit Chan

I hereby certify that this paper is being deposited this date with the U.S. Postal Service with sufficient postage for first class mail addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

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11/3/06

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